

Application No.: 10/697,014

IBM Ref. No.: YOR920030204US1
CBLH Docket No.: 20140-00305-US1REMARKS

Claims 6 – 31 are now in the application. Claims 6 – 12, 30 and 31 are directed to the elected invention. Claims 13 – 29 are directed to the non-elected invention and may be canceled by the Examiner upon the allowance directed to the elected invention.

The rejection of claims 1 – 5 under 35 USC 102(b) as being anticipated by U.S. Patent 2,196,307 to Hensel and of claims 1 – 5 under 35 USC 103(a) as being unpatentable over U.S. Patent 2,196,307 to Hensel have been rendered moot by the cancellation of these claims.

Claims 6 – 12 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 2,196,307 to Hensel in view of U.S. Patents 6,412,628 to Tramposch. Tramposch was relied upon for a disclosure that a beryllium oxide layer can be formed on an otherwise easily corroded silver electrical contact in order to prevent or inhibit the formation of tarnish. The cited references do not render obvious the above claims. As appreciated in the Office Action, Hensel does not suggest the invention as defined in claims 6 – 12 since, among other things, Hensel fails to suggest forming an oxide layer of the alloying metal or the recited alloy.

Tramposch does not overcome the above discussed deficiencies of Hensel with respect to rendering unpatentable the above claims since, among other things, Tramposch fails to even remotely suggest an oxide layer of about 1 to about 10 nanometers as recited in the claims. As discussed in the present specification, providing a relatively thin, e.g., about 2 to about 10 nanometers, oxide layer, significant capacitance increase is not caused by the layer. See page 6, lines 9 – 13. Also, the oxide layer typically has excellent heat conductivity. Moreover, nothing in Tramposch would suggest employing a thin layer. Also, it is not even apparent that such a thin oxide layer could even be achieved by the suggestions in Tramposch.

Furthermore, Tramposch actually teaches away from the invention of the above claims, since Tramposch explicitly states that oxides have disadvantages, and therefore, suggests using, instead, flexible absorbent articles.

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The cited art is even more remote with respect to claims 30 and 31 that recite "consisting essentially of." In reciting "consists essentially of" claims 30 and 31 exclude the presence of alloying metals such as lithium as required by Hensel in amounts that would materially change the basic characteristics of the claimed invention. See MPEP 2111.03.

The mere fact that cited art may be modified in the manner suggested in the Office Action does not make this modification obvious, unless the cited art suggest the desirability of the modification. No such suggestion appears in the cited art in this matter. The Examiner's attention is kindly directed to *In re Lee* 61 USPQ2d 1430 (Fed. Cir. 2002) *In re Dembiczak et al.* 50 USPQ2d. 1614 (Fed. Cir. 1999), *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), *In re Laskowski*, 10 USPQ2d. 1397 (Fed. Cir. 1989) and *In re Fritch*, 23, USPQ2d. 1780 (Fed. Cir. 1992).

In *Dembiczak et al.*, supra, the Court at 1617 stated: "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., *C.R. Bard, Inc., v. M3 Sys., Inc.*, 157 F.3d. 1340, 1352, 48 USPQ2d. 1225, 1232 (Fed. Cir. 1998) (describing 'teaching or suggestion motivation [to combine]' as in 'essential evidentiary component of an obviousness holding'), *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d. 1453, 1459 (Fed. Cir. 1998) ('the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them');..."

Also, the cited art lacks the necessary direction or incentive to those of ordinary skill in the art to render the rejection under 35 USC 103 sustainable. The cited art fails to provide the cited degree of predictability of success of achieving the properties attainable by the present invention needed to sustain a rejection under 35 USC 103. See *Diversitech Corp. v. Century Steps, Inc.* 7 USPQ2d 1315 (Fed. Cir. 1988), *In re Mercier*, 185 USPQ 774 (CCPA 1975) and *In re Naylor*, 152 USPQ 106 (CCPA 1966).

Moreover, the properties of the subject matter and improvements which are inherent in the claimed subject matter and disclosed in the specification are to be considered when evaluating the question of obviousness under 35 USC 103. See *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16

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USPQ2d. 1923 (Fed. Cir. 1990), *In re Antonie*, 195, USPQ 6 (CCPA 1977), *In re Estes*, 164 USPQ (CCPA 1970), and *In re Papesch*, 137 USPQ 43 (CCPA 1963).

No property can be ignored in determining patentability and comparing the claimed invention to the cited art. Along these lines, see *In re Papesch*, supra, *In re Burt et al*, 148 USPQ 548 (CCPA 1966), *In re Ward*, 141 USPQ 227 (CCPA 1964), and *In re Cescon*, 177 USPQ 264 (CCPA 1973).

In view of the above, reconsideration and allowance are, therefore, respectively solicited.

In the event that the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0510, under Order No. 20140-00305-US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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